

Applicant : Peter Ebert  
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Attorney's Docket No.: 13909-123001 / 2003P00145  
US

#### Response to Restriction Requirement

In restricting the claims into three groups, the office action indicates that each group of claims is classified in the same class / subclass, namely class 700, subclass 245.

As required by MPEP § 803, if the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

As required by MPEP § 806.05(c), to support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., there would be a serious search burden as evidenced by 1) separate classification, 2) status, or 3) field of search.

Applicant submits that the Examiner has not met the serious search burden requirement because the office action does not properly state any reasons for insisting that restriction is necessary. More specifically, the office action: 1) admits that each group of claims fall within the same classification, namely class 700, subclass 245; 2) the office action provides no statements that each group of claims has a separate status in the art (which for example may be shown by citing patents which are evidence of such separate status; MPEP 808.02); and 3) admits that each group of claims fall within the same field of search, namely class 700, subclass 245.

Thus, the serious burden requirement has not been met because the office action does not satisfy any one of the three criteria for supporting serious search burden. For at least this reason, Applicant respectfully requests the Examiner to withdraw the restriction requirement.

Paragraph 4 of the action states "Inventions III and II/I are related as combination and subcombination." Applicant interprets this notation to mean that for purposes of the restriction analysis, Group III (e.g. claim 22) is being identified as the combination, and that either one of Group II (e.g. claim 12) OR Group I (e.g. claim 1) is being identified as the subcombination (that relates to Group III). The third sentence of paragraph 4 then appears to conflict with the first sentence because in the third sentence, evidence claim 1 is then referred to as a combination claim, rather than as a subcombination claim. This issue was raised and discussed during the telephonic interview conducted on November 10, 2005, but no agreement was reached. Applicant was asked to respond to this issue in Applicant's written response.

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Applicant submits that the requirements for restriction according to combination and subcombination under MPEP § 806.05(c) are not properly met because the written analysis set forth in the action has not properly identified a subcombination claim.

Specifically, and in view of the Applicant's interpretation of paragraph 4, claim 12 cannot properly be interpreted as a subcombination of (combination) claim 22, and claim 1 cannot properly be interpreted as a subcombination of (combination) claim 22. The reason is that the construct of all of the independent claims is too similar for one independent claim to be identified as a subcombination of the elements in the other independent claim.

For example, and without limiting the scope of the pending claims, claim 22 generally recites a robot system comprising a robot ..., a sensor ..., a virtual world ... operable to input sensor data from the sensor ..., and a control system operable to direct the robot in performance of the task.

In comparison, and also without limiting the scope of the pending claims, claim 1 generally recites a robot system comprising a robot ..., a sensor ..., a receiver ... operable to receive task data ..., and a control module operable to associate data such that the robot performs the task.

Also for comparison purposes and without limiting the scope of the pending claims, method claim 12 generally recites collecting data at a sensor of a robot system to produce a first data stream, receiving a second data stream at the robot system, the second data stream including instructions for the robot system to perform a task, aggregating the first data stream and the second data stream ..., and performing the task with the robot system ....

In the present application, each of the independent claims have similar constructs and recite similar elements. However, each of these claims while having similarities are absolutely permitted to have different scope and be directed to different statutory categories (e.g. apparatus; method) without requiring restriction. The pending independent claims are simply not drafted in combination and subcombination format. Both system claims recite a robot system and the method claim recites process steps implemented by a robot system.

With regard to Applicant's interpretation of sentence 3 of paragraph 4 and the sentences that follow, Applicant submits that claim 12 cannot properly be identified as a subcombination of (combination) claim 1 according to MPEP § 806.05(c) II. Claim 12 recites aggregating the first

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data stream and the second data stream with respect to a common time reference. Thus, claim 12 recites these features in relatively broad terms. In contrast, Claim 1 recites that the control module is operable to associate the local status data and the task data with a common time reference. Thus, for comparison purposes (and without limiting the claims), claim 1 recites similar features in terms that are relatively more specific than those terms recited in claim 12.

In paragraph 4 of the office action, the analysis states that:

“where the combination evidence claim (AB br) [i.e. claim 1] does not set forth the details of the subcombination (B sp) [i.e. claim 12], and the subcombination (B sp) [i.e. claim 12] has separate utility, such as a robot system comprising a sensor, a receiver and a control module, the inventions are distinct and restriction is PROPER.” (emphasis added)

Applicant submits that the statement in paragraph 4 is both technically incorrect and confusing. The statement is technically incorrect because claim 1 does recite features in terms that are relatively more specific than those features of claim 12. Thus, the requirement that the combination DOES NOT set forth the DETAILS of the subcombination is not properly satisfied. The statement in paragraph 4 is confusing because the clause “and the subcombination (B sp) has separate utility” refers to method claim 12, while the clause “such as a robot system comprising a sensor, a receiver and a control module” used to support the Examiner's assertion that claim 12 has separate utility, refers to elements found in system claim 1, when to avoid confusion it appears that the “such as” clause should refer to process step elements found in claim 12, not elements found in system claim 1.

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Applicant also submits that information required to complete form paragraph 8.15 Combination-Subcombination is missing and not properly recited. The form paragraph suggests:

Inventions [1] and [2] are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations ( MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because [3]. The subcombination has separate utility such as [4].

The notes that follow form paragraph 8.15 require:

2. In bracket 3, specify the limitations of the claimed subcombination that are not required by the claimed combination. In situations involving evidence claims, see MPEP § 806.05(c), subsection II.

3. In bracket 4, suggest utility other than used in the combination.  
(emphasis added)

Applicant submits that with regard to bracket 3, paragraphs 4 and 5 of the office action do not specify any limitations of the claimed subcombination. Rather, the office action only refers generally to a grouping of claims, rather than specifying limitations from those claims. With regard to bracket 4, paragraphs 4 and 5 of the office action do not suggest utility other than used in the combination. If fact, a literal reading of paragraph 4 shows that the office action suggests the specific utility of the combination claim (claim 1). Thus, the requirement of suggesting utility other than used in the combination has not been met.